

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of : Abad-Peiro et al.
Serial No. : 09/787,753 Examiner : Muriel S. Tinkler
Filed : June 11, 2001 Art Unit : 3691
For : METHOD OF IMPROVING SECURITY IN
ELECTRONIC TRANSACTIONS

September 16, 2008

PRE-APPEAL BRIEF REQUEST FOR REVIEW

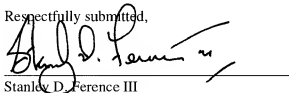
Box AF

Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

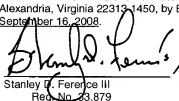
Applicants hereby request review of the final rejection in the above-identified application in accordance with the Pre-Appeal Brief Conference Pilot Program for the reasons stated in the attached remarks. No amendments are being filed herewith and this request is being filed with a Notice of Appeal. The Commissioner is hereby authorized to charge payment of any fees associated with this communication or credit any overpayment to Deposit Account No. 50-0510.

Respectfully submitted,



Stanley D. Ference III
Registration No. 33,879

I hereby certify that this correspondence and any documents referred to as enclosed therewith are being filed with the Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450, by EFS Web on September 16, 2008.


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REMARKS

The outstanding Office Action, dated June 16, 2008, rejected claims 1-20 and the rejection was made final. Of these claims, Claims 1, 7, 10, 13 and 16 are independent claims; the remaining claims are dependent claims. Claims 2, 3, and 18 stand rejected under 35 USC 101 as being directed to non-statutory subject matter. Claims 1-20 stand rejected under 35 USC 102(b) as being anticipated by Rowney et al. (US Patent No. 5,987,140) (hereinafter "Rowney").

There is Clear Error in the Examiner's Rejections

The invention is clearly claimed as a statutory computer implemented method and the cited art fails to teach or suggest the invention as currently claimed. Therefore, Applicant respectfully requests reconsideration and withdrawal of the rejections under 35 USC §§ 101 and 102(b).

Rejections under 35 USC § 101

Only *dependent* claims 2, 3 and 18 stand rejected under 35 USC § 101. Applicants respectfully submit that, as the Examiner acknowledges, these claims depend from statutory method claims and are therefore statutory as well. Therefore, Applicant respectfully requests reconsideration and withdrawal of these rejections.

The Examiner asserts that the use of insurance products versus other products is "non-functional", that the use of merchants as employees and users seeking employment is "non-functional", and that the use of an airport as the remote site is "non-functional".

Office Action, pp. 3. Applicant respectfully disagrees because the dependent limitations simply further narrow the terms of the independent claims (e.g. Claim 18 defines the remote site to be an airport). Applicant respectfully submits that the Examiner has confused prior art-type analysis with statutory subject matter analysis. See *Office Action*, pp. 2-3.

Therefore, Applicant respectfully requests reconsideration and withdrawal of these rejections.

Rejections under 35 USC § 102(b)

The Applicant is entitled to a patent unless the invention was patented or described in a printed publication more than one year prior to Applicant's filing. 35 USC 102(b). Rowney does not patent or describe the instantly claimed invention. Among the many differences between Rowney and the instantly claimed invention, Applicant respectfully submits the following brief summary.

As best understood, Rowney is directed to an entirely different method from the instantly claimed invention. As stated in Rowney,

FIG. 1B depicts an overview of the present invention...The customer-merchant session 150 operates under a general-purpose secure communication protocol such as the SSL protocol. Merchant computer system 130 is additionally in communication with payment gateway computer system 140...The merchant-institution session 170 operates under a variant of...the SET protocol.

Rowney, Col. 10, lines 4-16. In other words, Rowney is direct to a method of "transmitting payment information *from a customer to a merchant to a payment*

gateway...” *Id* at Col. 1, lines 12-13 (emphasis added). Rowney never mentions the use of a trusted third party because Rowney assumes trust between consumers and merchants.

This stands in stark contrast with the instantly claimed invention. The instantly claimed “method enables the user 18...to access the TTP 22 in order to request broker services...” *Specification*, pp. 13, lines 4-8. Nowhere does Rowney discuss using a trusted third party to communicate with merchants on behalf of the user.

The instant claims clarify that *the merchants that consumers wish to interact with are not trusted* (i.e. are not trusted third parties), so *a trusted third party* (which is not a merchant) *is utilized* by the customer in order to provide more secure and anonymous communications *with the merchants*. Claim 1 states, *inter alia*, “utilizing a network link between the user and the certified trusted third party and utilizing a network link between the certified trusted third party and the merchants...” Claim 1. Noticeably, there is no direct link between users and merchants, as in Rowney, Fig. 1B.

Thus, it is clear that a merchant is not a trusted party but rather another party (e.g. an insurance broker, *Specification*, pp. 6, lines 1-5 or an employment consultant, Claim 3) acts as a trusted third party. This trusted third party provides the additional computing resources on the customer’s behalf in order to transact securely with merchants. Thus, Rowney does not teach the utilization of a trusted third party as in the instantly claimed invention. Therefore, Applicant respectfully requests reconsideration and withdrawal of the rejections under 35 USC § 102(b).

Conclusion

In view of the foregoing, it is respectfully submitted that independent Claims 1-20 are clearly directed towards statutory subject matter and fully distinguish over the applied art and are thus allowable. It is respectfully submitted that the instant application, including Claims 1-20 is presently in condition for allowance. Notice to the effect is hereby earnestly solicited.